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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,091	09/23/2003	Louis Brown Abrams	4811-9-CON	6362
22442	7590	10/11/2005	EXAMINER	
SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			JUSKA, CHERYL ANN	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/670,091		ABRAMS, LOUIS BROWN	
	<b>Examiner</b>		<b>Art Unit</b>	
	Cheryl Juska		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 15-28 and 30-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/19/05 05/06/05 1-15-04 2-05-04</u>                                     | 6) <input type="checkbox"/> Other: _____                                    |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-14 and 29, in the paper filed July 26, 2005, is acknowledged. Claims 15-28 and 30-40 are hereby withdrawn as non-elected.

### ***Response to Amendment***

2. Applicant's preliminary amendments filed January 15 and February 5, 2004, has been entered.

### ***Specification***

3. The amendment filed February 9, 2004, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. Specifically, said amendment is drawn to two separate embodiments for the permanent adhesive, one being a hot melt adhesive (i.e., thermoplastic) and the other being a thermosetting adhesive. While the specification as originally filed employed the term "hot melt film" or "hot melt sheet," these recitations are not sufficient support for a disclosure to a thermoplastic hot melt adhesive, since said terms were employed throughout the specification to describe a thermosetting adhesive. Note applicant's discussion of prior art flock transfers at page 1, 2<sup>nd</sup> paragraph of *Background of the Invention* and page 3, 2<sup>nd</sup> paragraph of *Detailed Description of the Invention*. Throughout the discussion of the prior art flock transfers, the term "hot melt adhesive" is employed to describe the permanent

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adhesive layer. As applicant correctly notes in the Remarks section of the Amendment filed February 5, 2004, the definition of a "hot melt adhesive" is limited to thermoplastic materials. Now note applicant's discussion of the present invention at page 3, 2<sup>nd</sup> paragraph of *Brief Summary of the Invention* and page 5, line 25 - page 5, line 23. Throughout this discussion, applicant employs the terms "hot melt film" or "hot melt sheet," not "hot melt adhesive." Additionally, said "hot melt film" and "hot melt sheet" are taught as thermosetting adhesives. Hence, it is understood that said film or sheet is a preformed thermosetting adhesive that is subjected to heat to activate (i.e., hot melt film or sheet). Furthermore, note applicant's discussion of the difference between the prior art and the present invention at page 5, line 24 - page 6, line 2. This discussion consistently employs the term "hot melt adhesive" for describing the prior art while stating that that one aspect of the present invention is the absence of said "hot melt adhesive." Hence, applicant's invention is based upon the substitution of a thermosetting adhesive for the prior art combination of a binder adhesive and a thermoplastic hot melt adhesive (page 2, lines 1-2, page 4, lines 2-4, and page 5, line 24 - page 6, line 2). Therefore, applicant's amendment, which changes the scope of the specification to describe two embodiments wherein either a thermoplastic adhesive or a thermosetting adhesive is employed as the permanent adhesive, is considered new matter. Further support for this assertion can be found in applicant's own filing of a continuation-in-part application (09/735,721) from the present application's parent (09/621,830) which states the following:

[0005] In my co-pending application, I have described the usage of a thermoset film in lieu of the bond and powder for adhesion, which film, when subject to heat, adheres to the substrate, functions as an inherece for the flock. This current invention adds further enhancements to this process, by allowing the application and usage of a thermoplastic film, for adherence of the flock transfer.

Applicant is required to cancel the new matter in the reply to this Office Action.

*Drawings*

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Reference number “50” shown in Figure 3 is not described in the present application. It is also noted that “50” was not part of the parent application as originally filed. As such, the addition of “50” could render the present application “continuation-in-part” status rather than the present “continuation” status.

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to because Figure 3 is not described in the specification. Additionally, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “5” has been used to designate both the flock and the release agent.

A proposed drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-14 and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 18-53 of copending Application No. 09/621,830. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlap.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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11. Claim 1 is indefinite because the location of the thermosetting film is unclear with respect to the flock assembly. Is said thermosetting film adjacent to the free ends of the flock or is it the flock adhesive? Claim 29 is similarly rejected.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1, 6, 7, and 9-14 are rejected under 35 USC 103(b) as being anticipated by US 5,115,104 issued to Bunyan.

Bunyan discloses a flocked substrate comprising flock fibers embedded in a flock adhesive such as a thermosetting polyurethane adhesive (abstract and col. 4, lines 19-41).

Regarding claim 11, which limits the thermosetting adhesive to a preformed film before application to the flock and substrate, the cited prior art also anticipates said claim. Said limitation reflects the method of making the flock transfer assembly. As such, said limitation is not necessarily given patentable weight at this time since the claims are examined on the structure of the final product. It is asserted that the final product of the prior art has the same structural features of the present invention as described in the preceding paragraph. Therefore, claim 11 is also anticipated.

Claim 7 is similarly rejected in that the method step of pre-cutting the adhesive sheet is not necessarily given patentable weight at this time. Thus, claim 7 is also anticipated.



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Regarding claims 12 and 14, before the thermosetting adhesive is fully cured, said adhesive is not fully cross-linked. Thus, during manufacture at the point of contact between the adhesive and the flock before being cured, the claim limitation is met by the prior art. Therefore, claims 12 and 14 are also anticipated.

14. Claims 1-4, 6-14, and 29 are rejected under 35 USC 102(b) as being anticipated by US 4,687,527 issued to Higashiguchi.

Higashiguchi discloses a method of making flock patterns and the flock transfers employed (abstract). Specifically, Higashiguchi teaches paper release sheet 20 which is solidly flocked with fibers 18. As is conventional in the art, said flock is adhered to the paper release sheet by an adhesive having weaker adhesion than the permanent adhesive that bonds the flock to a final substrate (col. 1, lines 24-26). The free ends of the flock are adhered to a permanent adhesive 16 coated onto a fabric surface 12 in a desired pattern (col. 5, lines 2-17). Said adhesive 16 is a thermosetting adhesive (col. 4, lines 19-35 and 44-52 and col. 5, lines 39-42). Said thermosetting adhesive may be a polyurethane resin (col. 4, lines 53-59). Thus, Higashiguchi clearly anticipates the invention of claims 1-4, 6, 8-10, and 13.

Regarding claim 11, which limits the thermosetting adhesive to a preformed film before application to the flock and substrate, the cited prior art also anticipates said claim. Said limitation reflects the method of making the flock transfer assembly. As such, said limitation is not necessarily given patentable weight at this time since the claims are examined on the structure of the final product. It is asserted that the final product of the prior art has the same structural features of the present invention as described in the preceding paragraph. Therefore, claim 11 is also anticipated.



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Similarly, claim 29 is drawn to the product of the method of claim 15. However, the claim is examined based upon the structure of the final product and not the steps employed to make said product. It is reasserted that the final product of the prior art has the same structural features of the present invention.

Claim 7 is similarly rejected in that the method step of pre-cutting the adhesive sheet is not necessarily given patentable weight at this time. Thus, claim 7 is also anticipated.

Regarding claims 12 and 14, before the thermosetting adhesive is fully cured, said adhesive is not fully cross-linked. Thus, during manufacture at the point of contact between the adhesive and the flock before being cured, the claim limitation is met by the prior art. Therefore, claims 12 and 14 are also anticipated.

15. Claim 5 is rejected under 35 USC 103(a) as being unpatentable over the cited Higashiguchi reference.

While the cited prior art fails to teach a polyester thermosetting adhesive, it would have been obvious to one of ordinary skill in the art to substitute a polyester thermosetting resin for the polyurethane thermosetting resin since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore, claim 5 is also rejected.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHERYL A. JUSKA  
PRIMARY EXAMINER